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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,219	12/24/2001	Eric A. Belec	F-444	5243

919 7590 01/21/2004

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EXAMINER

ALIE, GHASSEM

ART UNIT PAPER NUMBER

3724

DATE MAILED: 01/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/036,219

Applicant(s)

BELEC ET AL.

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 10 . 6) ☐ Other: \_\_\_\_\_

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a first cutting edge having at least one notch, as set forth in claim 1 must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: “860” in Fig. 12.

A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

3. The specification is objected to under 37 CFR 1.71 for not disclosing that the first cutting wheel has at least one notch. The first cutting wheel 849 in the first embodiment and the first cutting wheel 862 in the second embodiment (which are shown respectively in Figs. 11 and 12) do not have a notch. However, the second cutting wheels 803 and 859 in the first and second embodiment have notches as shown respectively in Figs. 11 and 12. The specification fails to teach that the first cutting wheel in either one of the embodiments has a notch that interacts with the second cutting edge to create at least one of the plurality of slots. It is also not clear what is the purpose of at least notch on the cutting edge of the first cutting wheel. It is also not clear how the notch interact with the second cutting edge to create one of the plurality of slots. See pages 13-15 in the specification.

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4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 8, “a backing member” lacks antecedent basis in the specification. Applicant has stated that the backing member is the circular urethane wheel 862 that is disclosed in line 4, page 14 of the specification. However, the backing member is not positively disclosed in the specification. It is suggested that in response to this office action applicant amend paragraph 43 to positively state that circular urethane wheel 862 is a backing member.

***Claim Objections***

5. Claim 8 is objected to because of the following informalities: “and backing member” should be --and the backing member--. See claim 8, line 14. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 1, the specification fails to teach that the first cutting wheel in either one of the embodiments has a notch that interacts with the second cutting edge to create at least one of the plurality of slots. It is also not clear what is the purpose of at least

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notch on the cutting edge of the first cutting wheel. It is also not clear how the notch interact with the second cutting edge to create one of the plurality of slots.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite or failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, it is not clear how the notch of the first cutting wheel interacts with the cutting edge of the second cutting wheel. Regarding claim 8, “ the cutting nip” lacks antecedent basis. See claim 8, line 18. It is not clear which cutting nip applicant is referring to, since there are two cutting nips (a first cutting nips and a second cutting nips).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi (6,119,568). Regarding claim 1, Yamauchi teaches a device that is capable of cutting mailpieces 2 including a first cutter wheel 29, 31 having a first cutting edge. The cutting rollers 39, 31 define the first cutting wheel. The periphery of the cutting rollers 29, 31 by the recess 34 define the cutting edges of the first cutter wheel 29, 31. Yamauchi also teaches a second cutter wheel 18 includes a second cutting edge that has a plurality of notches 21. Yamauchi also teaches means for driving the first 29, 31 and the second cutter

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wheels 18. Yamauchi also teaches that the first 29, 31 and second 18 cutter wheels are positioned to define a cutting nip between the first and second cutting edges such that at times when a mailpiece passes through the cutting nip the interaction of the first cutting edge and the second cutting edge cut the mailpiece 2 except when the plurality of notches 21 are present at the cutting nip. The cutting nip is defined by the cutting edge of the cutting roller 18 and the cutting edge of the cutting rollers 29, 31. Yamauchi also teaches that the first cutting edge has at least one notch 34 that interacts with the second cutting edge to create at least one of the plurality of slots 7. See Figs. 1-9d and col. 1, lines 45-67 and col. 4-6, lines 1-67 in Yamauchi.

Regarding claim 8, Yamauchi teaches a device that is capable of cutting mailpieces 2 including a first cutter wheel 29, 31 having a first cutting edge. The cutting rollers 29, 31 define the first cutting wheel. The periphery of the cutting rollers 29, 31 by the recess 34 define the cutting edges of the first cutter wheel 29, 31. Yamauchi also teaches a second cutter wheel 18 includes a second cutting edge that has a plurality of notches 21 and vertical cutting edges 23, 24. Yamauchi also teaches that the vertical cutting edges 23, 24 are substantially perpendicular to the second cutting edge and extend downward from the second cutting edge. Yamauchi also teaches that each of the plurality of notches has a pair of vertical cutting edges 23, 24 each of which is disposed along a corresponding side of each of the plurality of notches 21. Yamauchi also teaches a backing member 34, 35. The recess 34 and the engaging portions 35 define the backing member. Yamauchi also teaches means for driving the first 29, 31 and second 18 cutter wheels and the backing member 34, 35.

Yamauchi also teaches that the first 29, 31 and second 18 cutter wheels are positioned to

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define a first cutting nip between the first and second cutting edges and the vertical edges 23, 24. The first cutting nip is defined by the cutting edge of the cutting roller 18 and the cutting edge of the cutting rollers 29, 31. Yamauchi also teaches that the backing member 34, 35 define a second nip. The second nip of the backing member 35, 34 is defined by the cutting edges on both sides of the recess 34. Yamauchi also teaches that the interaction of the first and second cutting edges makes the first cut in the mailpiece 2 except when the plurality of notches 21 are present at the cutting nip. Yamauchi also teaches that when the mailpiece 2 passes through the second cutting nip the vertical edges 23, 24 make a second cut in the mailpiece 2 substantially perpendicular to the first cut. The cuttings 7, 22 on the mailpiece 2 are capable of creating a castellated appearance, which includes open edge portions and unopened edge portions as shown in Fig. See Figs. 1-9d and col. 1, lines 45-67 and col. 4-6, lines 1-67 in Yamauchi.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gall et al. (4,699,035) in view of Cavagna (5,458,034). Regarding claim 1, Gall discloses device for perforating cutter that can be used for cutting mailpieces, the device includes a first cutter wheel 3 having a first cutting edge as shown in Fig. 3, a second cutter

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wheel 6 having a second cutting edge 19 and a plurality of notches 24 therein, and means 1, 2 to drive the first and second cutter wheels 3, 6 into rotation. Gall also discloses that the first and second cutter wheels 3, 6 are disposed to define a cutting nip between the first cutting edge and the second cutting edge 19 such that at times when a mailpiece passes through the cutting nip the interaction of the first cutting edge and the second cutting edge 19 is capable of cutting the mailpiece except when the plurality of notches 24 are present at the cutting nip. The cutting nip between the cutter wheels 3 and 6 is shown in Figs. 3 and 4. See Figs. 1-5 and col. 3, lines 1-60. Gall does not expressly teach that the first cutting edge has at least a notch that interacts with the second cutting edge to create at least one of the plurality of slots. However, Cavagna teaches a cutting apparatus 10 including a first cutter wheel 16 having a cutting edge, which has a notch 60 therein. The notch 60 interacts with the second cutting edge 14 to a material 72. The second cutter wheel 14 engages with the groove or notch 60 during the cutting or working stage. Therefore, the cutting edge of the cutting wheel 14 is interacting with the groove or notch 60 for cutting the material 72. See col. 3, lines 10-24 and col. 4, lines 20-57 in Cavagna. The material 72 is cut by combine work or interaction of the first cutting edge 16, the groove 60, and the second cutting edge 14. See Fig. 1 and col. 2, lines 19-54 and col. 4, lines 7-19 in Cavagna. It would have been obvious to a person of ordinary skill in the art to provide Gall's cutting device with the first cutter wheel as taught by Gall in order create a support surface for the materials passing through the nip between the cutting edges of the cutter wheels.

Claim 2 is canceled.

***Response to Amendment***



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13. Applicant's arguments filed on 11/03/03 have been fully considered but they are not persuasive. With respect to applicant's arguments regarding claim 1, applicant argument that Cavanga does not teach that the notch or groove of the first does not interacts with the second cutting edge to create a slot is incorrect. The notch of the first cutting wheel is not disclosed in the specification and the drawings. Therefore, it is not clear how the interaction of the notch of the first cutting edge with the second cutting edge of the instant invention is different than the interaction of the groove of the first cutting edge and the second cutting edge in Cavanga. In addition, Cavanga teaches that the second cutter wheel 14 engages with the groove or notch 60 during the cutting or working stage. Therefore, the cutting edge of the cutting wheel 14 is interacting with the groove or notch 60 for cutting the material 72. See col. 3, lines 10-24 and col. 4, lines 20-57 in Cavanga. The material 72 is cut by combine work or interaction of the first cutting edge 16, the groove 60, and the second cutting edge 14. See Fig. 1 and col. 2, lines 19-54 and col. 4, lines 7-19 in Cavanga.

Upon further review of the paragraph 1 in page 14 of the specification the drawing objection, the objection under 35 CFR 1.71, and rejection under 35 U.S.C 112 (with respect to the backing member not being shown or disclosed in the specification) are withdrawn.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** The new grounds of rejection of Claims 1 and 8 were necessitated by the amendments which added the limitation of "therein that interacts with the second cutting edge to create at least one of the plurality of slots" to claim 1 and "and extended downward from the second cutting edge" to claim 8. These limitations did not previously appear in Claims 1, 2, and 8. Accordingly, this action is made final. See MPEP §

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706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (703) 305-4981. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (703) 305-1082. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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January 14, 2004



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